

RECEIVED
CENTRAL FAX CENTER

APR 28 2004

OFFICIAL

The Goodyear Tire & Rubber Company

Akron, Ohio 44316-0001

Fax: (330) 796-9018

Facsimile Transmission

This transmittal is strictly intended for delivery only to the person listed below. It may contain confidential or privileged information, the disclosure of which is prohibited. If you have received this facsimile and are not the intended recipient, you are hereby notified that the copying, distribution, or other unauthorized use of this communication is prohibited. If you have received this communication in error, please notify us immediately by telephone to arrange for return of the document.

Date: April 28, 2004

To: John L. Goff II, Examiner
United States Patent & Trademark Office

Fax #: 8 703-872-9306

From: Nancy T. Krawczyk
Patent Attorney
The Goodyear Tire & Rubber Company
1144 East Market Street
Akron, Ohio 44316-0001
Telephone: (330) 796-6366 - GTN 446-6366

Number of pages transmitted: 4
INCLUDING this cover sheet

If problems with transmission, please call Lois Gould at 330-796-4617

Message:

Re: Patent Application Serial No. 10/069,432
Filed February 19, 2002
Confirmation No. 3710
Docket No. DN1999205USA

Transmitted herewith is a Response After Final in the above-identified patent application.

RECEIVED
CENTRAL FAX CENTER

APR 28 2004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

Applicant: Pedro Emilio Rengifo et al.)
For: Method of Making an Edge-Flow)
Resistant Laminate)
Serial No. 10/069,432)
Filed: February 19, 2002)
Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Confirmation No. 3710
Docket No. DN1999-205USA
Art Unit: 1733
Examiner: John L. Goff II

I hereby certify that this correspondence is being
transmitted to the USPTO via facsimile to 703-872-
9306, on April 28, 2004

(Date of Deposit)

Nancy T. Krawczyk
(Name of Registered Representative)

(Signature) 4.27.04
(Date of Signature)

RESPONSE AFTER FINAL

Dear Sir:

In response to the Office Action mailed on March 24, 2004, please consider the following remarks.

Claims 1-6 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Elliott (U.S. Patent 3,041,661) in view of Peterson (U.S. Patent 2,449,66).

The same rejection as set forth in the original Office Action has been repeated herein, almost word for word.

In response to the prior Office Action, Applicants raised the following issues:

- a) The use of restricting means in the background section of Elliot are not preforms;
- b) Peterson teaches a permanently fixed restrictive material - contrary to Elliot's desire for a non-permanent restrictive material; and
- c) The complete dissimilarities of the arts - Peterson having absolutely nothing to do with conveyor belt, or any type of belt, manufacturing.

These arguments have been deemed non-persuasive for the following reasons:

- a) The examiner was not relying on Elliot as teaching preforms with a fabricated channel; but "only referring to the teachings of Elliot that restrictive materials of a preformed shape (e.g. steel side bars or molded edge rings) are known in the art." The non-quite stated acknowledgement that the steel side bars or molded edge rings discussed by Elliot do not have preformed channels therein is appreciated.

b) The fact that Peterson teaches a permanently fixed restrictive material is ignored or considered irrelevant in the rejection. It is held that "the combination of Peterson and Elliot is not to place the preform of Peterson in Elliot rather Peterson is combined with Elliot as an exemplary teaching of it being well known and conventional *in the art* to apply a restrictive material" (emphasis added by Applicant). This leads to issue c) below.

c) In the repeated rejection, it is held that using either a "prefolded u-shape or folding the material to have a u-shape during its application as both methods were well known and conventional alternatives *in the art* for applying a restrictive material" (emphasis added by Applicant); Peterson being held as evidence of a known alternative *in the art*. However, Peterson is not relevant art for several reason: the product and method of manufacturing disclosed by Peterson is a brush, not a belt and the restrictive material disclosed becomes a permanent element of the product being produced contrary to Elliot.

This issue has not been addressed in the Final Office Action. In seeking to reject Applicants claims, the required elements of Graham v. Deere and other relevant patent law cannot be ignored in an attempt to force a rejection of the claims.

To establish *prima facie* obviousness, all three requirements of Graham v. Deere must be satisfied. The first element is a suggestion or motivation in the art to modify or combine the teachings. The motivation to combine can explicit or implicit, as outlined in Wesley Jessen Corp. v. Coopersvision Inc.:

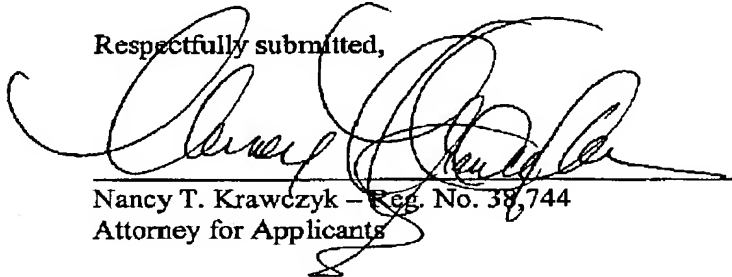
- 1) in the prior art itself - Elliot is looking for removable types of restrictive edge means for use during curing to prevent edge flow; Peterson discloses a permanent restrictive edge applied to a non-cured product that has no issue with edge flow as there is no curing;
- 2) in the knowledge of those of ordinary skill in the art that certain references are of special interest or importance in the field - Peterson is directed towards a brush - *no one* of ordinary skill in the art of belt making would find a brush manufacturing patent to be of "special interest or importance in the field";
- 3) from the nature of the problem to be solved - herein, the problem to be solved is to have a removable restrictive edging means for using during curing to prevent edge flow; one would not look to prior art that disclosed a permanent, non-removable restrictive edging means for a product that doesn't have to solve such a problem of edge flow during curing.

Furthermore, in deciding what is relevant art, the area or art should be "where one of

ordinary skill in the art would be aware that similar problems exist" Bott v. Four Start Corp. One skilled in the art of belt manufacturing, or even broader still, one skilled in the art of manufacturing laminates of multiple continuous or discrete length webs of elastomeric materials would not be aware of similar problems existing in Brush, Broom, and Mop Making. Brushes, brooms and mops are NOT laminates of multiple continuous or discrete length webs of elastomeric material – there is no reasoning presented in the rejection as to why one of skill in the art relevant to the present invention would be aware that a similar problem of wanting to temporarily secure opposing loose edges during curing would be present in brush, broom, and mop making. By using Peterson in the selective manner accomplished in the present invention, it is being implied that one of ordinary skill in the belt art must be aware of similar problems existing in the brush making art. This is far reaching on the part of the rejection. The use of Peterson in combination with Elliot appears to be hindsight based solely on Applicants teachings.

Reconsideration of the relevancy of Peterson, who teaches a permanent restrictive edge on a non-cured brush, to the teachings of Elliot, who discloses a desire to restrain the flowable edges of an elastomeric laminate belting. As Elliott in view of Peterson fails to establish *prima facie* obviousness under the mandatory requirements of Graham v. Deere, it is respectfully requested that the rejection be withdrawn. The Examiner is respectfully requested to allow all pending claims.

Respectfully submitted,



Nancy T. Krawczyk – Reg. No. 38,744
Attorney for Applicants

The Goodyear Tire & Rubber Company
Department 823
1144 East Market Street
Akron, Ohio 44316-0001
Telephone: (330) 796-6366
Facsimile: (330) 796-9018